

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: A. Chaiyawat et al.
Serial Number: 09/995,992
Filed: Nov. 16, 2001
Examiner: S. L. Howard
Art Unit: 1615
Title: TRANSFER RESISTANT COSMETIC COMPOSITIONS
COMPRISING SILICONE GELS

Honorable Commissioner of Patents and Trademarks
Washington, DC 20231

REQUEST FOR RECONSIDERATION

Dear Sir:

Responsive to the Examiner's Action mailed Feb. 12, 2003 reconsideration and allowance based on the following remarks is respectfully requested. Accompanying these remarks is a petition for a one month extension of time extending the time for response to June 12, 2003 and authorization to pay the fees therefore. Please consider the following remarks.

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner of Patents and Trademarks, Washington, DC 20231.

Date: June 11, 2003


Karen A. Hayden

REMARKS

Art Based Rejections Under 35 U.S.C. § 102(b) and 103(a)

Art Based Rejections Under 35 U.S.C. §102(b)

For a rejection to be sustainable under 35 U.S.C. § 102 the anticipating reference must identically disclose each and every element of the claimed invention, no more and no less. Trintec Industries v. TOP-U.S.A. Corp., 2002 U.S. App. LEXIS 13190 (Fed. Cir. 2002). "Anticipation requires identity of invention. The claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order to anticipate." Glaverbel Societe Anonyme v. Northlake Marketing & Supply Inc., 45 F.3d 1550, 33 U.S.P.Q.2d 1496, 1498 (Fed. Cir. 1995). *Glaverbel Societe Anonyme* merely restates longstanding doctrine: "[f]or a prior art reference to anticipate in terms of Section 102, every element of the claimed invention must be identically shown in a single reference. citing *Diversitech Corp. v. Centruy Steps, Inc.*, 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed Cir. 1988). These elements must be arranged as in the claim under review, citing *Lindenmann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) . . . " In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). The Examiner is respectfully reminded that in the context of anticipation under Section 102, the courts use the word "identity" in its mathematical sense, i.e. each and every element, no more and no less. *Supra*. Optional components may not be used to justify or sustain a rejection grounded in anticipation.

The Examiner has rejected claims 1, 3, 5, and 7 as being anticipated by WO 99/22696. The basis for this rejection is that WO 99/22696 "discloses using film forming agents which can confer transfer resistance to the makeup product." In making this rejection the Examiner has failed to give weight to the word "optional" which occurs in

the specification of WO 99/22696 at page 9, line 29. Further, Applicants do not utilize a film forming agent to confer transfer resistance (claim 1). Because the each and every element test required for a rejection under 35 USC 102(b) has not been met, by reason of the Examiner pointing to an additional optional ingredient in WO 99/22696 not specified or claimed instantly, Applicants respectfully submit the Examiner's rejection lacks merit. Accordingly withdrawal of this ground of rejection is respectfully requested.

Art Based Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-19 as unpatentable over WO 99/22696 in combination with Kilgour et al. US Patent 5,760,116. The Examiner has provided no motivation or line of reasoning based on the cited art that would suggest or motivate removing the optional film forming agent of the composition in WO 99/22696 based on the teachings and composition of the '116 the composition to arrive at Applicants' instant transfer resistant composition where Applicants' composition is missing the film forming agent required by WO 99/22696 for transfer resistance.

"Obviousness cannot be established by combining teachings of prior art to produce a claimed invention, absent some teaching or suggestion supporting the combination. Under section 103 (35 U.S.C.), teachings of references may be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)

Since the Examiner has not suggested a line of reasoning suggested by the art cited that would render obvious ~~the removal of the prior art film forming agent or~~ pointed to a teaching suggesting the removal of the film forming agent taught in WO 99/22696 and still arrive at Applicants' transfer resistant cosmetic composition, Applicants respectfully submit the Examiner has failed to make out a *prima facie* case for obviousness. Withdrawal of this ground of rejection is respectfully requested.

Applicants respectfully submit that a Notice of Allowance is next in order and respectfully solicit a Notice of Allowance for claims 1 - 19 the claims currently pending

Respectfully submitted:

Kenneth S. Wheelock

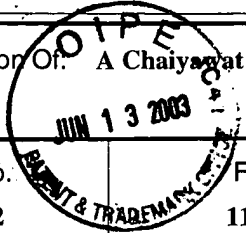
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COMBINED AMENDMENT & PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) (Large Entity)	Docket No. US 60SI1296-1
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In Re Application Of: A Chaiyagat et al.	#4
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Serial No. 09/995,992	Filing Date 11/16/2001	Examiner S.L. Howard	Group Art Unit 1615
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Invention: Transfer Resistant Cosmetic Compositions Comprising Silicone Gels	<div style="text-align: right;"> RECEIVED JUN 18 2003 </div>
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TO THE ASSISTANT COMMISSIONER FOR PATENTS:

This is a combined amendment and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the Office Action of 02/12/2003 in the above-identified application.
Date

The requested extension is as follows (check time period desired):

☒ One month
☐ Two months
☐ Three months
☐ Four months
☐ Five months

from: 05/12/2003 until: 06/12/2003
Date Date

The fee for the amendment and extension of time has been calculated as shown below:

CLAIMS AS AMENDED					
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	19 -	20 =	0	x \$18.00	\$0.00
INDEP. CLAIMS	4 -	4 =	0	x \$84.00	\$0.00
FEE FOR AMENDMENT					\$0.00
FEE FOR EXTENSION OF TIME					\$110.00
TOTAL FEE FOR AMENDMENT AND EXTENSION OF TIME					\$110.00

06/16/2003 CCHAU1 00000014 070888 09995992
01 FD:1251 110.00 DA